

Remarks

Applicants have canceled claims 2-9, 17, and 20 without prejudice and added new claims 21-91. The amendments are fully supported by the specification and claims as originally filed, and thus no new matter has been added. Originally filed claims 1, 10-12, 13-16 and 18-19, and new claims 21-91 will be pending upon entry of these amendments.

I. Amendment of the Claims.

Claims 2-9, 17 and 20 have been canceled in favor of new claims 21-91 in order to cover additional embodiments of the subject matter of the provisionally-elected group. Claim 1 has been amended to recite "SEQ ID NO:2" instead of "Figure 1." Claims 10-12, 16, 18 and 19 have been amended to depend from new claim 21. Applicants submit that the subject matter of new claims 21-91 falls within the scope of Group II, as defined by the Examiner in the Office Action mailed October 23, 2003 (Paper No. 2). New claims 21-91 find support in the claims as originally filed and throughout the specification. Specifically, support for new claims 21-91 is found, for example, at paragraphs 11, 13, 25, 42, 44, 66, 73-74, 97; at Figures 1-2; and in SEQ ID NO:2.

Accordingly, no new matter has been added by way of amendment. Entry of the above amendment is therefore respectfully solicited.

II. The Restriction Requirement.

Pursuant to Paper No. 2, mailed October 23, 2003, the Examiner has required an election under 35 U.S.C. § 121 of one of Groups I-IX. The Examiner contends that the inventions are distinct, each from the other.

In response, Applicants provisionally elect, *with traverse*, the invention of Group II represented by original claims 9 and 17 and newly added claims 21-91, drawn to polypeptides, for further prosecution. Applicants reserve the right to file one or more divisional applications directed to non-elected inventions should the restriction requirement be made final. Applicants point out that original claims 2-9, 17 and 20 have been canceled, and that new claims 21-91 are directed to subject matter falling within the ambit of Group II as cast by the Examiner.

With respect to the Examiner's division of the invention into nine groups and the reasons stated therefor, Applicants respectfully disagree and traverse. Even assuming, *arguendo*, that Groups I-IX represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." *See* M.P.E.P. § 803. In the present situation, no such showing has been made. Indeed, no arguments have been made explaining why it would impose a serious burden to examine Groups I- IX together. Applicants submit that a search of the polypeptide claims of Group II would provide useful information for Groups I and III- IX. For example, in many if not most publications disclosing a polypeptide sequence, the authors also routinely include polynucleotides, antibodies, agonists and antagonists, and methods for treatment, diagnosis, and screening using the same. Since the searches for polynucleotides, polypeptides, antibodies, agonists and antagonists, and methods for treatment, diagnosis, and screening using the same commonly overlap, the search and examination of a polypeptide, a corresponding polynucleotide sequence, corresponding antibodies, agonists and antagonists, and methods for treatment, diagnosis, and screening using the same would not entail a serious burden.

Accordingly, in view of M.P.E.P. § 803, the claims of all of Groups I-IX should be searched and examined in the present application. Applicants therefore respectfully request that the restriction requirement under 35 U.S.C. § 121 be reconsidered and withdrawn, and that the instant claims be examined in one application.

Further, although not acquiescing to the restriction requirement, Applicants nevertheless note that the claims of Group II and the claims of Group IX are related as between a product and a process for using the product. Moreover, the process claims of Group IX either depend from or otherwise include all of the limitations of the product claims of Group II. Pursuant to the procedures set forth in the Official Gazette notice dated March 26, 1996 (1184 O.G. 86), if an elected product claim is found allowable, “withdrawn process claims which depend from or otherwise include all of the limitations of the allowable product claim will be rejoined.” M.P.E.P. § 821.04. Accordingly, Applicants respectfully request that if any of the claims of Group II, *i.e.*, claims 21-91, are found allowable, then the process claims of Group IX be rejoined and examined for patentability.

Applicants retain the right to petition from the restriction requirement under 37 C.F.R. § 1.144.

Conclusion

Entry of the above amendment is respectfully solicited. In view of the foregoing remarks, Applicants believe that this application is now in condition for allowance, and an early notice to that effect is urged. The Examiner is invited to call the undersigned at the phone number provided below if any further action by Applicant would expedite the examination of this application.

Finally, if there are any fees due in connection with the filing of this paper, please charge the fees to our Deposit Account No. 08-3425. If a fee is required for an extension of time under 37 C.F.R. § 1.136 not accounted for in the Petition for an Extension of Time submitted concurrently herewith, such an extension is requested and the appropriate fee should also be charged to our Deposit Account.

Respectfully submitted,

Dated:

Nov. 13, 2003 

Melissa J. Pytel

(Reg. No. 41,512)

Human Genome Sciences, Inc.

9410 Key West Avenue

Rockville, MD 20850

Telephone: (301) 610-5764

Enclosures

KKH/MJP/KM/lcc